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Tadao Yoshida

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530 7590 01/12/2007  
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EXAMINER

THEIN, MARIA TERESA T

ART UNIT

PAPER NUMBER

3627

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

09/885,480

Applicant(s)

YOSHIDA ET AL.

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on October 16, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,6,17,21 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6,17,21 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 16, 2006 has been entered.

### ***Response to Amendment***

Applicants' "Request for Continued Examination" filed on October 16, 2007 has been considered.

Claims 1, 17 and 30 have been amended. Claims 3-5, 7-16, 18-20, 22-29 and 31-40 are cancelled. Claims 1-2, 6, 17, 21 and 30 remain pending in this application and an action on the merits follow.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 17, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,018,720 to Fujimoto in view of U.S. Patent No.**

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**6,834,348 to Tagawa et al. and in further view of U.S. Patent No. 6,434,535 to Kupka et al.**

Regarding claim 1, Fujimoto discloses an information distribution system having a terminal apparatus and an information center, in which a recording medium having recorded thereon unrewritable prepaid information (col. 3, lines 12-14; col. 5, lines 38-41; col. 8, lines 34-48) is loadable in the terminal apparatus to enable content data to be transmitted to the recording medium from the information center via a predetermined communication line (see at least Figure 1; Figure 2; col. 2, lines 46-65), the terminal apparatus comprising:

- first receiving means for receiving the content data transmitted from the information center (see at least col. 2, lines 46-65; col. 3, lines 1-4; col. 8, lines 61-66);
- recording and reproducing means for recording the content data received by the first receiving means onto the recording medium loaded by a purchaser in the terminal apparatus and reproducing an identifier unique to the recording medium (see at least col. 2, lines 46-65; col. 3, lines 1-35; col. 9, lines 40-55; col. 13, lines 4-47) and the unrewritable prepaid information, wherein the unrewritable prepaid information includes a prepaid amount of money, a prepaid service ID representative of an address of the information center (col. 3, lines 12-14; col. 5, lines 38-41; col. 8, lines 34-48; col. 10, lines 9-20; col. 10, lines 40-46; col. 13, lines 4-47);

- first transmitting means for transmitting the reproduced identifier unique to the recording medium and the reproduced unrewritable prepaid information (col. 3, lines 12-14; col. 5, lines 38-41; col. 8, lines 34-48) to the information center (see at least col. 3, lines 1-35; col. 9, lines 40-64; col. 6, lines 41-58);
- the information center comprising:
- first storage means for storing a plurality of content data (see at least col. 8, lines 16-24; Figure 1; col. 6, lines 22-23);
- second transmitting means for transmitting predetermined content data from the first storage means to the terminal apparatus (see at least col. 6, lines 23-38);
- second receiving means for receiving the identifier unique to the recording medium and the unrewritable prepaid information (col. 3, lines 12-14; col. 5, lines 38-41; col. 8, lines 34-48) transmitted from the terminal apparatus (see at least col. 6, lines 23-58; col. 13, line 63 – col. 14, line 5);
- second storage means for storing a usable remaining amount of money relative to the unrewritable prepaid information (col. 3, lines 12-14; col. 5, lines 38-41; col. 8, lines 34-48) in accordance with the identifier unique to the recording medium and the unrewritable prepaid information (col. 3, lines 12-14; col. 5, lines 38-41; col. 8, lines 34-48) received by the second receiving means (see at least col. 9, lines 56-col. 10, line 3; col. 13, line 63-col. 14, line 5);
- charging processing means for updating, when the predetermined content data are transmitted from the first storage means to the terminal apparatus, the usable remaining amount of money stored in the second storage means for a charge of

the predetermined content data transmitted from the first storage means to the terminal apparatus (see at least col. 3, lines 11-23; col. 8, line 63 – col. 9, line 5; col. 9, lines 56-col. 10, line 3; col. 13, line 63-col. 14, line 5); and

- first comparing means for comparing the remaining amount of money stored in the second storage means with a price of content data to be transmitted to said terminal apparatus (see at least col. 8, line 66- col. 9, line 3; col. 9, lines 56-64).

However, Fujimoto, does not expressly disclose wherein the prepaid amount of money included in the unrewritable prepaid information on the recording medium is not updated when said predetermined content data is transmitted from the first storage means to said terminal apparatus. Fujimoto discloses a new accounting system for use in transactions by utilizing communications by which additional data is referred to safely and easily. The additional data is added the record medium and is not updated (col. 15, lines 13-20).

Tagawa, on the other hand, teaches the recording medium is not updated when said predetermined content data is transmitted from the first storage means to said terminal apparatus (col. 26, lines 40-48; col. 2, lines 43-49; col. 3, lines 24-34).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to the system of Fujimoto, to include the recording medium is not updated when said predetermined content data is transmitted from the first storage means to said terminal apparatus, as taught by Tagawa, in order to provide a secure aria on the primary recording medium (Tagawa, col. 12, lines 9-11).

Furthermore, Fujimoto does not explicitly disclose when the remaining amount of money is found by the first comparing means to be less than the price of the content data to be transmitted, a control signal is transmitted from the information center to the terminal apparatus to instruct the terminal to prompt for the loading of a second recording medium; and adding means for adding a usable remaining amount of money.

Kupka, on the other hand, teaches the remaining amount of money is found by the first comparing means to be less than the price of the content data to be transmitted, a control signal is transmitted from the information center to the terminal apparatus to instruct the terminal to prompt for the loading of a second recording medium; and adding means for adding a usable remaining amount of money (see at least col. 4, lines 15-20; col. 5, lines 25-44; col. 5, lines 53- 58; col. 7, lines 48-65; col. 17, line 48-col. 18, line 28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to the system of Fujimoto, to include the remaining amount of money is found by the first comparing means to be less than the price of the content data to be transmitted, a control signal is transmitted from the information center to the terminal apparatus to instruct the terminal to prompt for the loading of a second recording medium; and adding means for adding a usable remaining amount of money, as taught by Kupka, in order to replenish the remaining balance (Kupka, col. 4, line 5).

Regarding claims 17, Fujimoto discloses an information center, connected to a terminal apparatus via a predetermined communication line, for distributing content data, comprising:

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- first storage means for storing a plurality of content data (see at least col. 6, lines 22-25);
- transmitting means for transmitting predetermined content data from said first storage means to said terminal apparatus (see at least col. 3, lines 24-36; col. 8, lines 16-24; col. 16, lines 9-19);
- receiving means for receiving from said terminal apparatus an identifier unique to a recording medium unrewritable prepaid information (col. 3, lines 12-14; col. 5, lines 38-41; col. 8, lines 34-48; col. 10, lines 22-24) stored wherein the unrewritable prepaid information includes a prepaid amount of money, a prepaid service ID representative of an address of the information center (col. 8, lines 34-48; col. 10, lines 41-46; col. 13, lines 4-47);
- second storage means for storing a usable remaining amount of money in accordance with said identifier unique to said recording medium and said unrewritable prepaid information (col. 3, lines 12-14; col. 5, lines 38-41; col. 8, lines 34-48) received by said receiving means (see at least col. 3, lines 4-23; col. 8, line 57 – col. 9, line 5; col. 9, lines 21-29);
- charging processing means for updating, when said predetermined content data are transmitted from said first storage means to said terminal apparatus, said usable remaining amount of money stored in said second storage means for a charge of said predetermined content data transmitted from said first storage means to said terminal apparatus (see at least col. 3, lines 11-23; col. 8, line 63 – col. 9, line 5; col. 9, lines 56-col. 10, line 3; col. 13, line 63-col. 14, line 5); and



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- first comparing means for comparing the remaining amount of money stored in the second storage means with a price of content data to be transmitted to said terminal apparatus (see at least col. 8, line 66- col. 9, line 3; col. 9, lines 56-64).

However, Fujimoto, does not expressly disclose wherein the prepaid amount of money included in the unrewritable prepaid information on the recording medium is not updated when said predetermined content data is transmitted from the first storage means to said terminal apparatus. Fujimoto discloses a new accounting system for use in transactions by utilizing communications by which additional data is referred to safely and easily. The additional data is added the record medium and is not updated (col. 15, lines 13-20).

Tagawa, on the other hand, teaches the recording medium is not updated when said predetermined content data is transmitted from the first storage means to said terminal apparatus (col. 26, lines 40-48; col. 2, lines 43-49; col. 3, lines 24-34). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to the system of Fujimoto, to include the recording medium is not updated when said predetermined content data is transmitted from the first storage means to said terminal apparatus, as taught by Tagawa, in order to provide a secure area on the primary recording medium (Tagawa, col. 12, lines 9-11).

Furthermore, Fujimoto does not explicitly disclose when the remaining amount of money is found by the first comparing means to be less than the price of the content data to be transmitted, a control signal is transmitted from the information center

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to the terminal apparatus to instruct the terminal to prompt for the loading of a second recording medium; and adding means for adding a usable remaining amount of money.

Kupka, on the other hand, teaches the remaining amount of money is found by the first comparing means to be less than the price of the content data to be transmitted, a control signal is transmitted from the information center to the terminal apparatus to instruct the terminal to prompt for the loading of a second recording medium; and adding means for adding a usable remaining amount of money (see at least col. 4, lines 15-20; col. 5, lines 25-44; col. 5, lines 53- 58; col. 7, lines 48-65; col. 17, line 48-col. 18, line 28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to the system of Fujimoto, to include the remaining amount of money is found by the first comparing means to be less than the price of the content data to be transmitted, a control signal is transmitted from the information center to the terminal apparatus to instruct the terminal to prompt for the loading of a second recording medium; and adding means for adding a usable remaining amount of money, as taught by Kupka, in order to replenish the remaining balance (Kupka, col. 4, line 5).

Regarding claim 30, Fujimoto discloses information distribution method for distributing content data from an information center to a recording medium loaded in a terminal apparatus said information center and said terminal apparatus being interconnected via a predetermined communication line, comprising the steps of:

- receiving an identifier unique to said recording medium and unrewritable prepaid information (col. 3, lines 12-14; col. 5, lines 38-41; col. 8, lines 34-48; col. 10,

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lines 22-24) recorded on said recording medium loaded by a purchaser in the terminal apparatus and transmitted from said terminal apparatus (see at least col. 6, lines 23-58; col. 13, line 63 – col. 14, line 5), wherein the unrewritable prepaid information includes a prepaid amount of money and a prepaid service ID representative of an address of the information center (col. 8, lines 34-48; col. 10, lines 40-46; col. 13, lines 4-47);

- storing, in a memory, a usable remaining amount of money relative to the unrewritable prepaid information (col. 3, lines 12-14; col. 5, lines 38-41; col. 8, lines 34-48) in accordance with said received identifier unique to said recording medium and said received unrewritable prepaid information (col. 3, lines 12-14; col. 5, lines 38-41; col. 8, lines 34-48; col. 3, lines 4-23; col. 8, line 57 – col. 9, line 5; col. 9, lines 21-29);
- comparing said usable remaining amount of money stored in said memory with a charge of content data to be distributed from said information center to said terminal apparatus (see at least col. 3, lines 11-23; col. 8, line 63 – col. 9, line 5; col. 9, lines 56-col. 10, line 3; col. 13, line 63-col. 14, line 5);
- permitting, when said usable remaining amount of money stored in said memory is greater than said charge of said content data to be distributed from said information center to said terminal apparatus, the transmission of said content data from said information center to said terminal apparatus (see at least col. 3, lines 11-23; col. 8, line 63 – col. 9, line 5; col. 9, lines 56-col. 10, line 3; col. 13, line 63-col. 14, line 5); and

- updating, by said charge of said content data, said usable remaining amount of money stored in a second memory when said content data are transmitted from said information center to said terminal apparatus (see at least col. 3, lines 11-23; col. 8, line 63 – col. 9, line 5; col. 9, lines 56-col. 10, line 3; col. 13, line 63-col. 14, line 5).

However, Fujimoto, does not expressly disclose wherein the prepaid amount of money included in the unrewritable prepaid information on the recording medium is not updated when said predetermined content data is transmitted from the first storage means to said terminal apparatus. Fujimoto discloses a new accounting system for use in transactions by utilizing communications by which additional data is referred to safely and easily. The additional data is added the record medium and is not updated (col. 15, lines 13-20).

Tagawa, on the other hand, teaches the recording medium is not updated when said predetermined content data is transmitted from the first storage means to said terminal apparatus (col. 26, lines 40-48; col. 2, lines 43-49; col. 3, lines 24-34).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to the system of Fujimoto, to include the recording medium is not updated when said predetermined content data is transmitted from the first storage means to said terminal apparatus, as taught by Tagawa, in order to provide a secure area on the primary recording medium (Tagawa, col. 12, lines 9-11).

Furthermore, Fujimoto does not explicitly discloses when the remaining amount of money is found by the first comparing means to be less than the price of the content

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data to be transmitted, a control signal is transmitted from the information center to the terminal apparatus to instruct the terminal to prompt for the loading of a second recording medium; and adding means for adding a usable remaining amount of money.

Kupka, on the other hand, teaches the remaining amount of money is found by the first comparing means to be less than the price of the content data to be transmitted, a control signal is transmitted from the information center to the terminal apparatus to instruct the terminal to prompt for the loading of a second recording medium; and adding means for adding a usable remaining amount of money (see at least col. 4, lines 15-20; col. 5, lines 25-44; col. 5, lines 53- 58; col. 7, lines 48-65; col. 17, line 48-col. 18, line 28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to the system of Fujimoto, to include the remaining amount of money is found by the first comparing means to be less than the price of the content data to be transmitted, a control signal is transmitted from the information center to the terminal apparatus to instruct the terminal to prompt for the loading of a second recording medium; and adding means for adding a usable remaining amount of money, as taught by Kupka, in order to replenish the remaining balance (Kupka, col. 4, line 5).

**Claims 2, 6 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,018,720 to Fujimoto and U.S. Patent No. 6,834,348 to Tagawa et al. and U.S. Patent No. 6,434,535 to Kupka, as applied to claims 1 above, and further view of U.S. Patent No. 6,144,745 to Akiyama et al.**

Regarding claim 2, Fujimoto and Tagawa and Kupka substantially discloses the claimed invention, however, the combination does not disclose the recording medium also records information about a remaining recordable capacity thereof, the information is reproduced by the recording and reproducing means, the reproduced information is transmitted by the first transmitting means to the information center. The combination discloses the purchaser may increase the number of game software recorded therein within storage or memory capacity thereof (Fujimoto, col. 9, lines 12-15). Furthermore, the combination discloses blocks of data purchased by the purchaser (Fujimoto, see at least col. 10, lines 19-21). Akiyama, on the other hand, teaches the recording medium also records information about a remaining recordable capacity (see at least col. 6, lines 57-64).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination, to includes the recording of the remaining recording capacity, as taught by Akiyama, so as to be notified as to whether there is left a capacity enough to store the data (Akiyama col. 6, lines 60-61).

Regarding claims 6 and 21, Fujimoto and Tagawa and Akiyama substantially discloses the claimed invention, however, the combination does not the excess of the price of said content, the identifier unique to the recording medium and the prepaid information stored in the storage means are edited.

Kupka, on the other hand, teaches the excess of the price of said content, the identifier unique to the recording medium and the prepaid information stored in the storage means are edited (col. 17, line 64-col. 18, line 8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to the combination, to include the excess of the price of said content, the identifier unique to the recording medium and the prepaid information stored in the storage means are edited, as taught by Kupka, in order provide an efficient payment mechanism (Kupka, col. 3, line 11).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-2, 6, 17, 21 and 30 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mtot *W* 7  
January 8, 2006

*Michael Cuff* 1/8/08  
**MICHAEL CUFF**  
**PRIMARY EXAMINER**